

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Patent Application of:
John C. Harvey *et al.*

Appeal Number: 2007-2115

Application No.: 08/487,526

Filed: June 7, 1995

For: SIGNAL PROCESSING APPARATUS AND
METHODS

Confirmation No.: 7792

Art Unit: 2627

Examiner: W. J. Klimowicz

REQUEST FOR REHEARING UNDER 37 C.F.R. § 41.52

MS Appeal Brief
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir or Madam:

This request is responsive to the Decision by the Board of Patent Appeals and Interferences (“Board”) issued January 13, 2009. Appellants note that the Board has asserted a new ground of rejection in the Decision. Appellants have filed concurrently, with this Request, an Amendment Reopening Prosecution under 37 C.F.R. § 41.50(b)(1) regarding the new ground of rejection. In this Request, appellants identify three points which the Board has misapprehended in its Decision as to the legal requirements forming the basis of the affirmed rejection and/or the content of the applied art. Appellants respectfully request rehearing of the Decision with respect to these three points.

I. ZABOKLICKI LACKS AN ENABLING DISCLOSURE

In the Decision, the Board affirmed the Examiner’s rejections of claims 2-6, 11-18, 20-23, 26, 27, 37-42, 67-69 and 82-84 under 35 U.S.C. § 102(b) as anticipated by German Patent Publication DE 2,904,981 (“Zaboklicki”). The Board also affirmed the rejections of claims 76

and 79-81 under § 103(a) as unpatentable over U.S. Patent 4,413,281 (“Thonnart”) and Zaboklicki. The Decision fails to establish that Zaboklicki is enabling. For this reason, appellants respectfully request that the Board reconsider its affirmance of these rejections.

A. DECISION FAILS TO ADDRESS THE REQUIREMENT THAT A REFERENCE MUST BE ENABLING

The failure of the Decision to address the issue of whether the disclosure or alleged “teaching” of the Zaboklicki reference is an enabling disclosure under the relevant legal standards is manifest error. To qualify as an anticipatory printed publication under 35 U.S.C. § 102, a reference must describe the claimed invention at issue in an understandable, clear and cogent manner. That description *must* not just be a vague description of the components of an invention but must enable a person of ordinary skill in the art to which the invention pertains to understand the functional operation of the invention *and* provide that person the ability to practice it. Appellants argued that the Zaboklicki reference was not an enabling reference as to any alleged teaching set forth therein. The Zaboklicki disclosure does not place the public in possession of an invention and does sufficiently describe how to make any invention alleged to be described so as to qualify as an enabling disclosure under 35 U.S.C. § 102. The Decision fails to include any determination regarding whether the Zaboklicki reference is enabling. Rather, the Decision asserts that “Zaboklicki is good for everything it teaches one of ordinary skill in the art.” Decision at 53. This statement which forms the basis of the affirmance of the rejections based on Zaboklicki is clearly erroneous.

In order to anticipate, a prior art reference must not only disclose all of the limitations of the claimed invention, but also be enabled.

Amgen Inc. v. Hoechst Marion Roussel, Inc., 457 F.3d 1293, 1306–07, 79 USPQ2d 1705, 1714 (Fed. Cir. 2006), *reh'g en banc denied*, 469 F.3d 1039 (Fed. Cir. 2006), *cert. denied*, 550 U.S. 953 (2007) (citing *Elan Pharms., Inc. v. Mayo Found.*, 346 F.3d 1051, 1054, 68 USPQ2d 1373 (Fed. Cir. 2003)). A reference is not good for everything it describes where the reference’s teaching does not enable one skilled in the art to make and use the claimed invention at issue.

Long established precedent establishes that a reference cannot simply recite general representations regarding a conglomeration of elements. Rather, the reference must enable those

skilled in the art to understand how to use the disclosed elements to achieve the invention alleged to be anticipated.

Patented inventions cannot be superseded by the mere introduction of a foreign publication of the kind, though of prior date, unless the description and drawings contain and exhibit a substantial representation of the patented improvement, in such full, clear, and exact terms as to enable any person skilled in the art or science to which it appertains, to make, construct, and practice the invention to the same practical extent as they would be enabled to do if the information was derived from a prior patent. Mere vague and general representations will not support such a defence, as the knowledge supposed to be derived from the publication must be sufficient to enable those skilled in the art or science to understand the nature and operation of the invention, and to carry it into practical use. Whatever may be the particular circumstances under which the publication takes place, the account published, to be of any effect to support such a defence, must be an account of a complete and operative invention capable of being put into practical operation.

Seymour v. Osborne, 78 U.S. (11 Wall.) 516, 555 (1870).

It is well settled that prior art under 35 U.S.C. §102(b) must sufficiently describe the claimed invention to have placed the public in possession of it. Such possession is effected if one of ordinary skill in the art could have combined the publication's description of the invention with his own knowledge to make the claimed invention. Accordingly, even if the claimed invention is disclosed in a printed publication, that disclosure will not suffice as prior art if it is not enabling.

In re Donohue, 766 F.2d 531, 533, 226 USPQ 619, 621 (Fed. Cir. 1985). The Decision fails to set forth how the Zaboklicki reference enables any invention it is alleged to anticipate.

The Decision notes that “Zaboklicki is a short reference.” Decision at 53. In fact, the Transperfect translation¹ of Zaboklicki consists of four pages of claims and eight pages of description (two of which are merely a list of reference numbers). The Decision, in spite of its assertion of Zaboklicki’s simplicity, takes eight pages to describe the “teaching” of the reference in detail. Decision at 53-61. Appellants respectfully submit that the Decision is in error because

¹ Both the Office and appellants have entered translations of Zaboklicki in the record of this application.. References herein to Zaboklicki are to the Transperfect translation and use the handwritten page number within circles as did the Decision.

it has taken the elements listed in Zaboklicki and described their relationships when the Zaboklicki reference itself fails to explain such relationships—the panel rewrites the reference to compel its conclusion using applicants’ own disclosure and hindsight to impute meaning. The Zaboklicki reference simply does not place any invention in the possession of one of ordinary skill in the art. Rather, the “description” or explanation made by the Board of the “teaching” of the Zaboklicki reference is required for one of ordinary skill in the art to understand the workings of the “system” described by the Board.

That Zaboklicki as written teaches nothing is highlighted by the fact that the Examiner asserted multiple “interpretations” of Zaboklicki against appellants’ claims. Decision at 61. The Decision itself highlights this point. Even after describing the Zaboklicki reference in detail, the Decision does not simply compare the described “teaching” of Zaboklicki to the claimed subject matter to determine that Zaboklicki teaches each element of the claimed invention. Rather, the Decision recognizes that the Examiner failed to respond to appellants’ arguments regarding the flaws of Zaboklicki. Decision at 63. Thus, to answer the question whether the claims are so broad that they read on Zaboklicki, the Decision reads the claims on the various interpretation of the reference proffered by the Examiner until the rejection succeeds or breaks down. *Id.* In other words, the Examiner has taken the elements taught by Zaboklicki and assembled them in various manners in an attempt to arrive at appellants’ claimed invention. The Decision, rather than looking to see what is actually taught by Zaboklicki, simply reviews the interpretations by the Examiner and discards interpretations that are inconsistent. Decision at 66. Even if this approach could lead to a conclusion that Zaboklicki discloses a list of the limitations found in the claimed invention, it nevertheless, fails to demonstrate how the Zaboklicki reference would teach and enable applicants’ claimed invention as whole. The Decision fails to demonstrate that the Zaboklicki reference itself demonstrates an enabling possession of the claimed subject matter as required by the case law. The Decision does not establish that one of skill in the art would, upon a review of the Zaboklicki reference, understand the nature and operation of the invention as claimed in the claims of the pending application.

B. THE ZABOKLICKI DISCLOSURE IS NOT ENABLED UNDER THE RELEVANT CASE AUTHORITY

The Zaboklicki reference does not include any cogent explanation as to how its objectives are to be achieved as is required to enable one of skill in the art to make and use its alleged “invention”. Zaboklicki states:

[T]he broadcasts that are transmitted to the greatest number of television viewers, e.g. sports and entertainment programs, i.e., broadcasts that are typically viewed by more than one person on a single television set, are provided with additional information in the form of additional audio signals. . . . On the receiver side . . . the separate variants of the additional information are transmitted in the form of acoustic or audio signals . . . in the infrared band to the individual infrared receivers, which are arranged in the known infrared transmitters for remote control of television receivers. In these transmitters, the keypad is used . . . to enter the television viewer's answers. The central processor . . . injects at certain time intervals the information that corresponds to the respective television viewer based on the digital processing program. This information is again forwarded in the infrared band to the infrared receiver arranged next to the ear phones. Additional information in the form of alphanumeric or graphic characters is used less frequently in this type of broadcast, i.e. only in an area where the attention of other persons using the same television receiver is not unduly distracted.

Zaboklicki at 8. Zaboklicki thus appears to disclose that the infrared band is used to send audio signals from a television receiver to ear phones of multiple users. However, Zaboklicki includes no disclosure as to how this simultaneous communication over the infrared band to multiple users is to be accomplished. Zaboklicki includes no disclosure regarding how a particular user receives a particular selected audio signal on the infrared band. He provides no disclosure as to how interference between audio signals transmitted to multiple viewers is to be avoided. Zaboklicki indicates that alphanumeric characters could be used in an area where the attention of other persons using the same television receiver is not unduly distracted. But he provides no explanation of what such an area would comprise. Zaboklicki states that he would provide individual viewers the ability to select individual supplements, explanations or other information to be presented in the programming. However, he does not explain how, where multiple users select alternative content, a particular user determines which alphanumeric characters displayed on the television are a result of that particular user's selection as opposed to someone else's

selection. He provides no explanation as to how any such display would not be unduly distracting to other viewers.

Zaboklicki goes on to state:

Broadcasts for a smaller group, such as educational and popular science broadcasts, are provided with additional information in the form of both audio signals and video signals. To this end, the signals of the local central processor switch from the reception of moving pictures to the reception of alphanumeric and graphic characters, likewise the identification data selector circuits for the individual parts (fragments) of the broadcast. The television channels are also switched if the individual fragments of a broadcast can be transmitted in more than one television channel. Furthermore, the output signals of the central processor switch the recording and replay of the information in the local information source.

Zaboklicki at 9. Again, Zaboklicki provides no disclosure as to how individuals of the smaller group control the switching of moving pictures to alphanumeric characters or the switching of individual fragments on more than one television channel. He sets forth no disclosure regarding how the “digital processing program” handles different requests or responses from different viewers that require different presentations.

Zaboklicki then states:

Another feature of the system according to the invention is the television viewer's participation in the centrally transmitted broadcast in such a way that the output signals of the local central processor insert the contours of the persons designated by the director in the viewfinder of the television camera. The figure of the viewer contained in these contours is overlaid on the main content.

Zaboklicki at 9. But Zaboklicki includes no disclosure regarding how the selected contour of the viewer is obtained or how the selected contour is overlaid on the main content. Zaboklicki simply describes a series of features and elements, but provides none of the details required by one of ordinary skill in the art to actually understand how to achieve Zaboklicki's stated objectives or to practice Zaboklicki's alleged “invention.”

C. ZABOKLICKI DOES NOT ENABLE APPELLANTS' CLAIMED INVENTION

The Decision finds with respect to claim 2:

By process of elimination of unviable alternatives in the rejection, and as discussed above, we find that “information from a first of said at least two media” corresponds to the “telesoftware” stored in the central processor RAM, where the first medium is “teletext data.” We also find that the step “determining content of a second medium received in said plurality of signals” corresponds to detecting “identification data” of the broadcast data fragments, where the second medium is the television program. Zaboklicki describes coordination of audio and video by switching based on “identification data of the individual fragments of a broadcast” (TransPerfect Translation, p. 3, claim 6, and p. 4, claim 10, and p. 6, claim 28) under control of the centrally transmitted digital processing program (telesoftware). Thus, a “presentation using said information” corresponds to audio presentation, where the presentation “uses” telesoftware information because the processor is controlled by the telesoftware to perform the audio channel switching. A “presentation of said second medium” is presentation of the television program. The presentations are “coordinated” “based on said step of determining” because audio and video are presented together based on the determining of identification data of appropriate program fragments and the viewer’s input.

Decision at 68. The Decision provides no explanation as to how Zaboklicki is enabling with respect to this alternative combination of elements as assembled in the Examiner’s rejection.

The Decision interprets the “digital processing program” of Zaboklicki as “telesoftware” and further asserts that this “telesoftware” is received in teletext data. Decision at 64. Zaboklicki states:

On the transmit side, special broadcasts are prepared involving a significant amount of labor, which have excess data for branching, together with a digital processing program for the individual data fragments that are provided in the broadcast.

* * *

On the receive side, according to the invention, a local central processor is provided in the private television receiver, which switches the data selector systems based on the television viewer’s answer and based on the centrally transmitted digital processing program for the broadcast segments (broadcast fragments).

Zaboklicki at 8. Zaboklicki, however, includes insufficient information for one of ordinary skill in the art to determine how the digital processing program functions or how to implement such a digital processing program. Zaboklicki merely states:

A central processing unit or processor 6, e.g., an integrated microprocessor, supplies the digital processing program, a television viewer's answers and the subsequent identification data of the individual parts or fragments of a broadcast to a memory 7 (RAM).

Zaboklicki at 10. In the list of reference numbers Zaboklicki also states:

41. Data selector circuit or circuit to compare the addresses of teletext information, e.g., page numbers, the local central processor /6/ switches the data selector circuits based on the television viewer's answers and the digital manipulation programs /telesoftware/, which is directed through the output circuits of the central processor /49/; if these addresses match, the subsequently arriving data is entered in the memory /44/

Zabocklick at 13. These brief references to “programs,” whether they are to “digital processing programs” or “digital manipulation programs,” are totally unclear as to how such “programs” should function. These vague descriptions fail to describe how any Zaboklicki “program” would operate to achieve the functions ascribed to them by the Decision and fail to describe how to make such a “program” perform said functions.

Zaboklicki merely makes reference to the presence of digital “programs” in his disclosure. The Decision, however, assumes that any operation of the receiver of Zaboklicki is under control of such digital “programs.” The Decision asserts:

Zaboklicki describes coordination of audio and video by switching based on “identification data of the individual fragments of a broadcast” (Transperfect Translation, p. 3, claim 6, and p. 4, claim 10, and p. 6, claim 28) under control of the centrally transmitted digital processing program (telesoftware).

Decision at 68. The Decision provides no citation for the proposition that the coordination is under control of the “digital processing program.” This is because, as discussed above, Zaboklicki provides no description to enable one of ordinary skill in the art to determine how to

make any digital “program” achieve the results ascribed to such a “program” in the Decision. Zaboklicki mentions a “digital processing program” and “digital manipulation programs,” but fails to set forth what such “programs” are intended to do or how they operate. The Decision takes this omission by Zaboklicki as an invitation to fill in what is not present in the Zaboklicki disclosure and ascribe functions to the digital “programs” they do not possess. However, one of ordinary skill in the art, not having the benefit of appellants’ specification, would have no reason to believe that the digital “programs” function as asserted in the Decision. To be valid prior art to appellants’ invention, Zaboklicki **must adequately describe and enable such invention with in the four corners of the Zaboklicki reference itself.** The Board may not rely on appellants’ disclosure to show how the Zaboklicki reference is enabled. Zaboklicki simply does not place one of ordinary skill in the art in possession of appellants’ claimed invention.

D. CONCLUSION

Zaboklicki does not enable any invention in such a manner to allow one of ordinary skill in the art to understand how to achieve the desired results. Zaboklicki, thus, is not a proper anticipatory reference against appellants’ claims. The failure of the Decision to address the non-enabling nature of Zaboklicki is clear error. Accordingly, appellants request that the Decision be reconsidered and that the rejections based on the Zaboklicki reference be reversed. As the Zaboklicki reference does not include an enabling disclosure, it is not available as anticipatory prior art against appellants’ claims. Accordingly, appellants requests that the rejections of claim 2-6, 11-18, 20-23, 26, 27, 37-42, 67-69 and 82-84 as anticipated by Zaboklicki be reversed.

The Zaboklicki reference is relied upon in the Decision to teach each limitation of claims 76 and 79-81 to affirm the Examiner’s rejection over Thonnart and Zaboklicki. “If the rejection over Zaboklicki alone cannot be affirmed, then Thonnart does not aid the rejection.” Decision at 104. The Decision does not analyze claims 76 and 79-81 under 35 U.S.C. § 103. Rather, the Decision finds that each element of claims 76 and 79-81 is taught by Zaboklicki. Thonnart is not relied upon for any teaching in the affirmance of the rejections of claims 76 and 79-81. However, as discussed above, a proper anticipatory reference must not only disclose all of the limitations of the claimed invention, but must also be enabled. Zaboklicki is not an enabling reference for the reasons discussed above. Appellants respectfully submit that the

Board's reliance on the non-enabling disclosure of Zaboklicki is clear error and request that the Board reverse the rejections of claims 76 and 79-81.

II. ROBINSON FAILS TO TEACH REFERENCE TO SPECIFIC TELETEXT PAGE NUMBER

In its Decision, the Board affirmed the rejection of claims 2, 3, 5-8, 11-16, 20-23, 37 and 67-69 under 35 U.S.C. § 103 as being unpatentable over Japanese Patent Publication JP 55-045248 ("Tsuboka") and Gary Robinson and William Loveless, *"Touch-Tone" Teletext, A Combined Teletext-Viewdata System*, IEEE Trans. on Consumer Electronics, Vol. CE-25, No. 3, July 1979 ("Robinson"). Decision at 114-26.

Robinson is said to disclose appellants' claim limitation of determining content of a medium. As recognized in the Decision, "The issue is whether Robinson discloses that news programs include references to teletext page identifiers." Decision at 117. The Decision improperly concludes that Robinson discloses that the news programs do include references to teletext page identifiers.

Robinson states that "stories could be set up in the Teletext format and made available to the public. . . . News programs on television could refer a viewer to these pages to get the detail that is cut out due to time limitations." (Robinson, p. 300, ll. 16-22.) The second sentence teaches that something in the news program will indicate to the viewer the page number of related teletext. For example, the news program might contain a verbal or visual message stating "refer to teletext page 5 for more details on the carjacking." Appellants do not explain how Robinson can be interpreted differently.

Decision at 117. Contrary to law, the Decision reads the relied upon second sentence in Robinson in light of appellants' own invention. Robinson does not teach that something in the news program will indicate to the viewer the specific page number of related teletext. Rather, Robinson teaches that news programs can generally refer viewers to teletext pages (*i.e.* a teletext service) to get details not available in the television broadcast. Robinson includes no other indication or other disclosure that any identifier is broadcast in the news program to identify a specific teletext page as assumed in the Decision.

The Decision postulates: “For example, the news program might contain a verbal or visual message stating “refer to teletext page 5 for more details on the carjacking.” *Id.*

However, Robinson includes no teaching that the news program does in fact include such a verbal or visual message, as would be critical to a finding that Robinson teaches determining content of a medium. In contrast, the Robinson news program could well contain a verbal or visual message stating “for more information regarding the stories on tonight’s newscast please access our teletext system.” In fact, this alternative is more consistent with the entire teachings of Robinson. Robinson recognizes that a large wait time is required to send a large number of teletext pages. Robinson, p. 300. Robinson addresses the problem of large wait times with a hybrid teletext/viewdata system named “Touch-Tone” Teletext. Robinson, p. 301.

[The “Touch-Tone” Teletext system] would use only a few pages of the regular Teletext system. These few pages would be high priority pages. The viewer would select one of these pages and then dial the telephone number shown on the TV screen. The computer . . . would answer the phone and send out an index page over the air.

Id. From this passage, it becomes clear to the reader that Robinson contemplates systems in which specific page identifiers are not required in the television program. Rather, the system could be accessed through a few general pages that provide indexes to specific pages.

Robinson simply does not disclose and/or teach including an explicit reference to a specific program-related teletext page in a television program. To the contrary, Robinson refers a viewer to “pages” generally. Robinson p. 300, l. 21. The reliance in the Decision on the hypothetical scenario that a “news program might contain a verbal or visual message” referring to a specific teletext page number is manifest error as Robinson simply includes no such teaching. For this reason, appellants request reconsideration of the rejections over Tsuboka in view of Robinson. For instance, the limitation of claim 20 of *said first of said plurality of signals including an identifier* is not taught or suggested by Robinson because Robinson does not teach that the television program includes a reference to a specific teletext page as asserted in the Decision.

For the above reasons, appellants request that the Board reconsider its affirmance of the rejection of claims 2, 3, 5-8, 11-16, 20-23, 37 and 67-69 under 35 U.S.C. § 103 as being unpatentable over Tsuboka and Robinson and that these rejections be reversed.

III. FUNCTIONAL CLAIMING IS NOT PROHIBITED

In the Decision, the rejections of claims 70-73 under 35 U.S.C. § 112, second paragraph, as being indefinite are affirmed. Decision at 44. The Decision announces a bright line test that “purely functional claiming where the statement of function is not attached to any structure or act, or to any ‘means’ or ‘step,’ is not permitted.” No authority is cited to support this principle asserted against appellants’ claims. The reliance by the Decision on this non-existent principle of patent law is manifest error.

As mandated by the definiteness requirement of 35 U.S.C. Section 112, Para. 2, a specification shall include claims “*particularly pointing out and distinctly claiming* the subject matter which the applicant regards as his invention” (emphasis added). Determining whether a claim is definite requires an analysis of “whether one skilled in the art would understand the bounds of the claim when read in light of the specification If the claims read in light of the specification reasonably apprise those skilled in the art of the scope of the invention, Section 112 demands no more.”

Personalized Media Communications LLC v. Int’l Trade Comm’n, 161 F.3d 696, 705, 48 USPQ2d 1880, 1888 (Fed. Cir. 1998) (quoting *Miles Lab., Inc v. Shandon, Inc.*, 997 F.2d 870, 875, 27 USPQ2d 1123, 1126 (Fed. Cir. 1993)). No analysis of whether one skilled in the art would understand the bounds of claims 70-73 when read in light of the specification is presented or upheld in the Decision. In lieu of such analysis, the Decision finds: “The functions ‘generated’ and ‘identifying content’ are purely functional and, therefore, indefinite under § 112 ¶ 2 because they are not expressly tied to any specific structure, such as the microprocessor structure.” Decision at 49. To support this conclusion, the Decision divides functional language into three classes: 1) structure, material, or acts for performing a function; 2) a means or step for performing a function under 35 U.S.C § 112, sixth paragraph and 3) “purely functional” language. Decision at 45. The Decision appears to conclude that the weight of authority holding that functional language is not *per se* indefinite applies only to functional language in classes 1

and 2. Decision at 45-46. The Decision then asserts that the purely functional language of class 3 is not permitted. Contrary to this assertion, no such principle is found in the law.

The decision cites to *Halliburton Energy Services Inc. v. M-I LLC*, 514 F.3d 1244, 85 USPQ2d 1654 (Fed. Cir. 2008) as support for the concept of “purely functional” language. However, *Halliburton* does not state that “purely functional” language is not permitted. Rather, *Halliburton* states:

When a claim limitation is defined in purely functional terms, the task of determining whether that limitation is sufficiently definite is a difficult one that is highly dependent on context (e.g., the disclosure in the specification and the knowledge of a person of ordinary skill in the relevant art area).

Halliburton at 1255, 85 USPQ2d at 1663. Thus, “purely functional” language is permitted where the context is sufficient for one of ordinary skill in the art to determine the scope of the invention. *Halliburton* is cited in *Microprocessor Enhancement Corp. v. Texas Instruments Inc.*, 520 F.3d 1367, 1375, 86 USPQ2d 1225, 1230 (Fed. Cir. 2008) which finds “the use of functional language in a claim may fail to provide a clear-cut indication of the scope of the subject matter embraced by the claim and thus can be indefinite” (internal quotations omitted). The statement in *Microprocessor Enhancement* that functional language “*can be* indefinite” does not support the holding of the Decision that “purely functional” language is not permitted.

The Decision finds that the functions “said information based on said second medium is generated” and “identifying content of said second medium” are not specified to be a result of the microcomputer structure. Decision at 49. These functions however are tied to the microcomputer structure. The functional language is directed not to the subject of the recited claim limitations but rather to their objects. There is nothing inherently indefinite when using functional language to further define an object in a claim limitation. For instance, a claim limitation could specify “a scanner for scanning a wall, wherein the scanner determines the presence of windows in the wall” or “a scanner for scanning a wall, wherein the scanner determines the presence in the wall of a material that passes light.” The fact that the hypothetical scanner is for detecting something that is defined in functional language (a material that passes light) does not necessarily render such claim language indefinite. Such language is not prohibited *per se* as “purely functional” language, rather such language must be analyzed in

context to determine whether it apprises one of ordinary skill in the art of the scope of the invention. There is no prohibition on “purely functional” language as asserted in the Decision.

For the above reasons, appellants believe that the affirmance of the rejections of claims 70-73 is erroneous and respectfully request that this rejection be reversed. The limitation “wherein, said information based on said second medium is generated based on identifying content of said second medium” is clear to one of ordinary skill in the art. The recited microcomputer executes processor instructions to enable a coordinated presentation including information based on said second medium. The information is thus tied to the microcomputer. The information is further defined as generated based on identifying content of said second medium. The Decision does not explain why this limitation, albeit defined in functional terms, would not apprise one of ordinary skill in the art of the scope of the invention. The Decision effectively asserts that, because the functional language does not directly refer to the microprocessor, but rather to the information tied to the microprocessor, the limitation is *per se* indefinite. For the reasons set forth above, no legal basis exists for this assertion. Appellants respectfully request that the Board reconsider the rejections of claims 70-73 and reverse them.

IV. CONCLUSION

The affirmance of the rejections of claims 2-6, 11-18, 20-23, 26, 27, 37-42, 67-69 and 82-84 as anticipated by Zaboklicki, of claims 76 and 79-81 as unpatentable over Thonnart and Zaboklicki, of claims 2, 3, 5-8, 11-16, 20-23, 37 and 67-69 as being unpatentable over Tsuboka and Robinson, and of claims 70-73 as being indefinite each include specific errors as set forth above. Appellants respectfully request that the affirmance of these rejections be reconsidered and that the rejections of these claims be reversed.

Dated: March 13, 2009

Respectfully submitted,

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